

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 23

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte GEORGE MORTIMER TIFFANY, III,  
GEORGE CONRAD L'HEUREUX,  
and  
JOHN HENRY SMYTHE

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Appeal No. 1999-0543  
Application No. 08/807,210

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ON BRIEF

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Before GARRIS, WALTZ, and PAWLIKOWSKI, Administrative Patent Judges.

GARRIS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the refusal of the examiner to allow claims 8, 10 and 11 as amended subsequent to the final rejection. These are all of the claims remaining in the application.

The subject matter on appeal relates to a fuel-lubricant composition consisting essentially of a fuel suitable for a two-

Appeal No. 1999-0543  
Application No. 08/807,210

cycle engine and a two-cycle oil consisting of a mixture of poly-n-butenes and polyisobutylene, a normally liquid naphthenic aliphatic solvent and a lubricating oil. Further details of this appealed subject matter are set forth in representative independent claim 8 which reads as follows:

8. A fuel-lubricant composition consisting essentially of about 20-250 parts by weight of a fuel suitable for a two-cycle engine per 1 part by weight of a two-cycle oil consisting of:

- a) 28-32% by weight of a mixture of a poly-n-butenes and polyisobutylene having a number average molecular weight of about 300 to 1500;
- b) 26-30% by weight of a normally liquid naphthenic aliphatic solvent having a boiling point of up to 300°C;
- c) 40-44% by weight of a lubricating oil having a viscosity 20-40 cSt at 40°C; and
- d) 0-2% by weight of a lubricating oil additive other than a polybutene polymer.

The references set forth below are relied upon by the examiner as evidence of obviousness:

Miyaji et al. (Miyaji)	5,049,291	Sep. 17, 1991
Japanese Reference (published Japanese Kokai Patent Application)	7,409,504	Jan. 28, 1974

Appeal No. 1999-0543  
Application No. 08/807,210

All of the claims on appeal are rejected under 35 U.S.C. § 103 as being unpatentable over the Japanese Reference in view of Miyaji.<sup>1</sup>

We refer to the brief and to the answer for a complete exposition of the opposing viewpoints expressed by the appellants and by the examiner concerning the above-noted rejection.

#### OPINION

We will sustain this rejection for the reasons which follow.

The record before us establishes that the reference evidence adduced by the examiner supports a prima facie case of obviousness within the meaning of 35 U.S.C. § 103 notwithstanding appellants' arguments to the contrary.

In this latter regard, the appellants argue that the Japanese Reference is directed to an oil composition for a two-cycle gasoline engine having a separate oiling system whereby the gasoline and oil are separately fed to the engine as distinguished from the appealed claims which are directed to a mixture of fuel and oil for a two-cycle engine. This argument is unpersuasive. Although the gasoline and oil of the Japanese

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<sup>1</sup>On page 3 of the brief, the appellants indicate that the appealed claims are grouped together. Accordingly, in assessing the merits of the rejection before us, we need focus only on claim 8 which is the sole independent claim on appeal.

Appeal No. 1999-0543  
Application No. 08/807,210

Reference are separately fed to the engine, these ingredients would necessarily mix together upon being injected into the engine combustion chamber. Albeit transitory, this mixture would constitute a fuel-lubricant composition in accordance with the here-claimed invention. Stated otherwise, the independent claim on appeal does not distinguish over a fuel-lubricant composition which exists as a mixture in the combustion chamber of a two-cycle gasoline engine pursuant to the Japanese Reference disclosure.

The only other argued distinction advanced by the appellants on this appeal relates to the examiner's reliance upon the Miyaji reference. Specifically, the examiner points out that the Japanese Reference composition includes polyolefins such as polyisobutylene and polybutene (e.g., see the second full paragraph on translation page 2) and concludes that Miyaji would have suggested using polyisobutylene and polybutene together as a mixture in accordance with clause (a) of appealed independent claim 8. According to the appellants, this conclusion is improper because lines 32-33 in column 1 of Miyaji teach away

from compositions of the type under consideration which include mineral oil in combination with polybutene. This argument is unpersuasive for a number of reasons.

First of all, Miyaji's aforementioned disclosure would not have discouraged using mineral oil in combination with polybutenes under all circumstances in view of the express teaching in the Japanese Reference that a composition having these ingredients is very effective in the environment of a two-cycle engine. Moreover, Miyaji's disclosure relates to a composition which contains mineral oil and polybutene as "main" components (see lines 28-33 in column 1). Thus, patentee teaches providing his composition with one or more polybutenes as a "minor" component preferably in an amount of 5 to 40% by weight (see lines 53-68 in column 2). Further, contrary to the appellants' belief, Miyaji teaches providing his composition with a mineral oil though "in minor" or small amounts (e.g., see the paragraph bridging columns 3 and 4). For these reasons, and since the Japanese Reference composition includes these ingredients in amounts which are "minor" (i.e., less than 50; see the first full paragraph on translation page 3), we are unpersuaded by the appellants' argument that Miyaji would have taught away from the examiner's proposed modification of the Japanese Reference composition.

Appeal No. 1999-0543  
Application No. 08/807,210

In addition to the forgoing, it is appropriate to emphasize that, even in the absence of the Miyaji reference, it would have been obvious for one with ordinary skill in the art to provide the Japanese Reference composition with a mixture of the polyisobutylene and polybutene ingredients disclosed in this reference as desirable polyolefins for use in the reference composition. This is because it is prima facie obvious to combine two components each of which is taught by the prior art to be useful for the same purpose in order to form a third composition which is to be used for the very same purpose; the idea of combining them flows logically from their having been individually taught in the prior art. In re Kerkhoven, 626 F.2d 846, 850, 205 USPQ 1069, 1072 (CCPA 1980). Thus, the Japanese Reference teaching of compositions containing either polyisobutylene or polybutene would have suggested a composition containing polyisobutylene and polybutene together as a mixture as required by the independent claim on appeal.

For the above-stated reasons, we will sustain the examiner's Section 103 rejection of appealed claims 8, 10 and 11 as being unpatentable over the Japanese Reference in view of Miyaji.

Appeal No. 1999-0543  
Application No. 08/807,210

The decision of the examiner is affirmed.

No time period for taking any subsequent action in  
connection with this appeal may be extended under 37 CFR  
§ 1.136(a).

AFFIRMED

BRADLEY R. GARRIS	)	
Administrative Patent Judge	)	
	)	
	)	
THOMAS A. WALTZ	)	BOARD OF PATENT
Administrative Patent Judge	)	APPEALS AND
	)	INTERFERENCES
	)	
	)	
BEVERLY A. PAWLIKOWSKI	)	
Administrative Patent Judge	)	

BRG:hh

Appeal No. 1999-0543  
Application No. 08/807,210

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